

**REMARKS**

The May 23, 2003 Official Action and references cited therein have been carefully reviewed. In light of the amendments presented herewith, inventor's declaration, and the following remarks, favorable reconsideration and allowance of the application are respectfully requested.

At the outset, Applicants acknowledge the Examiner's statement that claims 25-27, 30, 48 and 49 are allowable.

Applicants have canceled claims 12, 18, 19, 23, 24, 39, 44-46 and 50 by the claim amendments presented hereinwith.

Applicants gratefully acknowledge the Examiner's statement that claims 12, 13 and 29 are allowable if rewritten in independent claim format. The reference to media comprising leukemia inhibitory factor (LIF) in claim 12 has been inserted in claim 1, which, it is submitted, is now in condition for allowance. Since claims 13 and 29 depend from claim 12, the applicant has amended these claims to depend from amended claim 1. It is submitted that claims 2-11 and 14-17 which depend from claim 1 are also now allowable.

Independent claims 20, 31 and 47 have also been amended to refer to media comprising LIF.

**Claim Rejections under 35 U.S.C. §112, First Paragraph**

Claim 17 was rejected on the basis of lack of written description for the term "inhibitor of TFG-beta superfamily signal transduction." The Examiner acknowledged in the last line of page 8 of the Office Action that Noggin and Cerberus family members meet the written description provision. In order to facilitate prosecution, claim 17 has been amended to refer to Noggin or a compound from the Cerberus family of proteins.

Claims 44-46 were rejected for lacking enablement. These claims have been canceled.

Claims 1-11, 14-24, 28, 31-38, 40-43 and 47 were rejected as not enabled for methods where the culture medium does not comprise LIF. The examiner acknowledged that the claims were enabled for a method where the cells are cultured in medium comprising LIF (page 11 of Office Action). Accordingly, claims 1-11, 14-17, 20-22, 28, 31-38, 40-43, and 47 have been amended to refer to LIF. Claims 18, 19, 23, and 24 were canceled.

Claims 39 and 50 were rejected as lacking enablement and failing to comply with the written description requirement. These claims have been canceled.

#### **Claim Rejections under 35 U.S.C. §102**

Claims 33-40 were rejected as anticipated by the abstract Tropepe et al. (1999) *Soc. Neurosci Abstracts* 25:527. The Examiner indicated that a declaration stating that Sirard did not contribute to the concepts in Tropepe et al. April 2001 *Neuron* 30:65-78 would overcome this objection. The Applicants enclose inventors' declarations referring to the abstract and the corresponding poster (the poster was submitted with the information disclosure statement dated May 23, 2003). The Applicant does not admit that either of these references are citable prior art publications, but encloses the declarations to facilitate prosecution. It is submitted that claims 33-38 and 40 are now allowable. Claim 39 was canceled.

#### **CONCLUSION**


In view of the amendments presented herewith, the inventor's Declaration, and the foregoing remarks, it is respectfully urged that the rejections set forth in the May 23, 2003 Official Action be withdrawn and that this application be passed to issue. In the event the Examiner is not persuaded as to the allowability of any claim, and it appears that any outstanding issues may be resolved through a

telephone interview, the Examiner is requested to telephone the undersigned attorney at the phone number given below.

Respectfully submitted,

DANN DORFMAN HERRELL & SKILLMAN, P.C.

By



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Tong Li

Registration No. 47,748

Tel: 610-563-4100

Enclosures: Inventor's declaration